

REMARKS

Claims 37-41 and 43-58 were pending in the present application. Claims 49-58 were previously withdrawn from consideration. By virtue of this response, claim 41 has been cancelled and claim 37 has been amended. Accordingly, claims 37-40, 43-48 are currently under consideration. Amendment or cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

Drawings

The drawings stand objected to under 37 CFR 1.83(a). The Office Action states that the drawings must show every feature of the invention specified in the claims, and therefore, the clip being T-shaped (as supported in paragraph 93 in the current specification) must be shown in the drawings.

To expedite prosecution, Applicants have cancelled claim 41, which is the only claim that recites a T-shaped clip. As such, the objection to the drawings under 37 CFR 1.83(a) is now moot.

Interview Summary

Applicants thank Examiner Ryckman for extending the courtesy of a telephonic interview on January 21, 2011 with the Applicants' representatives Ann Yang and Walter Wu. During the interview, proposed amendments to independent claim 37 were discussed. The proposed amendments recited a pushing member with a channel, where a tether of a tethered clip assembly is retained in the channel. Written description support for these amendments was discussed, and Examiner Ryckman agreed that the specification provided sufficient support for the proposed amendments. Examiner Ryckman also proposed that the claim be amended to recited that the pushing member is in a distal portion of the shaft. The proposed amendments, including the amendments suggested by Examiner Ryckman, have been incorporated in claim 37 above and described further below. Examiner Ryckman agreed that these claim amendments overcome the 35 U.S.C. §102 rejection over U.S. Pat. Appl. Pub. No. 2002/0087169 to Brock.

Claim Amendments

Claim 37 has been amended to recite a device for applying a tethered clip assembly to annular tissue of a heart valve comprising “*a shaft having a proximal portion and a distal portion; and a pushing member within the distal portion configured to advance a clip of a tethered clip assembly within the distal portion, wherein a tether of the tethered clip assembly is retained within a channel in the pushing member...*” Written description support for this amendment may be found in the specification, for example, in FIGS. 17-19. Claim 41 has been cancelled. No new matter has been added.

Claim Rejections – 35 USC §102

Claims 37-40 and 44-48

Claims 37-40 and 44-48 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Pat. Appl. Pub. No. 2002/0087169 to Brock (“Brock”). The Office Action states that Brock discloses a device for applying at least one clip to annular tissue, the device comprising a shaft and at least one actuator at or near the proximal end of the shaft for causing the device to advance a tethered clip assembly from the shaft.

As discussed during the interview and described above, Applicants have amended independent claim 37 to recite a device for applying a tethered clip assembly comprising “a shaft having a proximal portion and a distal portion; and a pushing member within the distal portion configured to advance a clip of a tethered clip assembly within the distal portion, wherein a tether of the tethered clip assembly is retained within a channel in the pushing member.” As discussed and agreed upon during the interview, Brock fails to disclose or suggest a device with a pushing member having a channel that retains a tether of a tethered clip assembly. Furthermore, Brock provides no guidance or motivation for one of ordinary skill in the art at the time of the invention to modify the system disclosed in Brock to include Applicants’ claimed pushing member. Since Brock fails to disclose or suggest each and every element of claim 37, a rejection of claims 37-40 and 44-48 under 35 U.S.C. §102(e) cannot stand. Applicants respectfully request that the rejection be withdrawn.

*Claim Rejections – 35 USC §103*Claim 41

Claim 41 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Brock as applied to claim 37 above, and further in view of WO 02/053011 A2 to Friedman (“Friedman”). The Office Action states that Brock discloses the invention as claimed, but concedes that Brock fails to disclose that the anchor is T-shaped. The Office Action relies on Friedman to cure this deficiency. Applicants respectfully disagree with this rejection.

However, to expedite prosecution, claim 41 has been cancelled. As such, the rejection of claim 41 under 35 U.S.C. §103(a) is now moot.

Claim 43

Claim 43 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Brock as applied to claim 40 above, and further in view of U.S. Pat. No. 5,984,933 to Yoon (“Yoon”). The Office Action states that Brock discloses the invention as claimed, but concedes that Brock fails to disclose that a clip with two eyelets. The Office Action relies on Yoon to remedy this omission, alleging that it would have been obvious for one of ordinary skill in the art at the time of the invention to use two eyelets and two tethers to aid in correct placement of the clips in the tissue of the heart valve. Applicants respectfully disagree with this rejection.

As explained above, Brock fails to disclose or suggest a device with a pushing member having a channel that retains a tether of a tethered clip assembly. Using a clip with two eyelets and two tethers as disclosed in Yoon fails to cure this deficiency. Furthermore, Yoon teaches a surgical apparatus for suturing tissue, and without any guidance from either Yoon or Brock, one of ordinary skill in the art at the time of the invention would not modify the intravascular device of Brock according to the surgical device disclosure of Yoon. For at least these reasons, a rejection of claim 43 under 35 U.S.C. §103(a) cannot stand.

Double Patenting**Claims 37-41 and 43-48**

Claims 37-41 and 43-48 stand rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 1-36 of U.S. Pat. No. 6,986,775 (the '775 patent). Applicants acknowledge that the Examiner has received the terminal disclaimer submitted for the '775 patent, and that no further action is needed from the Applicants at this time.

Claims 37-41 and 43-48

Claims 37-41 and 43-48 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 1-100 of copending U.S. Pat. Appl. No. 11/237,461; claims 37-46 of copending U.S. Pat. Appl. No. 12/131,840; and claims 58-94 of copending U.S. Pat. Appl. No. 12/132,375.

Applicants will consider filing terminal disclaimers to reference each of the patent applications listed above after receiving an indication that each of the currently rejected claims is allowable. Until then, Applicants have no real way of assessing the merits of the double patenting rejection or determining whether the filing of a terminal disclaimer is appropriate.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 578492000510. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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